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APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/724,233		12/01/2003	Arne Holm	P63882US1	3256
136	7590	02/23/2006		EXAMINER	
JACOBSO 400 SEVEN		MAN PLLC	WESSENDORF, TERESA D		
SUITE 600				ART UNIT	PAPER NUMBER
WASHINGTON, DC 20004				1639	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
	10/724,233	HOLM ET AL.	
Office Action Summary	Examiner	Art Unit	
	T. D. Wessendorf	1639	
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet wi	th the correspondence addr	ess
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DOWN THE MAILING DOWN THE MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNIC 36(a). In no event, however, may a rewill apply and will expire SIX (6) MON 6, cause the application to become AB	CATION. eply be timely filed THS from the mailing date of this common (ANDONED) (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on			
	action is non-final.		
3) Since this application is in condition for allowar	nce except for formal matt	ers, prosecution as to the n	nerits is
closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D	. 11, 453 O.G. 213.	
Disposition of Claims			
4)⊠ Claim(s) <u>84-95</u> is/are pending in the application	n.		
4a) Of the above claim(s) is/are withdraw			
5) Claim(s) is/are allowed.			
6) Claim(s) is/are rejected.	•		
7) Claim(s) is/are objected to.			
8) Claim(s) <u>84-95</u> are subject to restriction and/or	r election requirement.		
Application Papers			
9)☐ The specification is objected to by the Examine	er.		
10) The drawing(s) filed on is/are: a) acc	epted or b)☐ objected to	by the Examiner.	
Applicant may not request that any objection to the	drawing(s) be held in abeyan	ce. See 37 CFR 1.85(a).	
Replacement drawing sheet(s) including the correct	tion is required if the drawing	(s) is objected to. See 37 CFR	? 1.121(d).
11)☐ The oath or declaration is objected to by the Ex	caminer. Note the attached	Office Action or form PTO)-152.
Priority under 35 U.S.C. § 119			
12) ☐ Acknowledgment is made of a claim for foreign a) ☐ All b) ☐ Some * c) ☐ None of:		119(a)-(d) or (f).	
1. Certified copies of the priority document			
2. Certified copies of the priority document			.
3. Copies of the certified copies of the prio	Ť	received in this National Si	tage
application from the International Bureat * See the attached detailed Office action for a list		received	
	or and derained depice net		
Attachment(s)			
1) Notice of References Cited (PTO-892)		Summary (PTO-413)	
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	. —	s)/Mail Date nformal Patent Application (PTO-1	152)
 Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 	6) Other:		·,

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 84-93 and 95 drawn to a method of solid phase peptide synthesis, classified in class 530, subclass 333+.
- II. Claim 94, drawn to a ligand presenting assembly, classified in class 530, subclass 300+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by solution phase synthesis or fragment synthesis.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of

Application/Control Number: 10/724,233 Page 3

Art Unit: 1639

their recognized divergent subject matter, and the search required for Group I is not required for Group II, specifically the literature searches, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

If Group I is elected, applicant(s) is/are to elect a single species as follows (i.e., one species from A, one from B and one from C):

- A. Formula I (with respect to the length of amino acids i.e., 4-20).
 - B. Formula II
- C. Peptide sequences from claim 90 or 95 i.e., a single peptide sequence.

Each of the species covered in each of the genus differs in structure and mode of action. A prior art reference anticipating one species would not render obvious the other species.

If Group II is elected, applicant(s) is/are to elect a single species as follows (i.e., a species included in e.g., Formula (1), if elected. Formula (1) is a genus, not a species):

- A. Formula (1)
- B. Formula (2)
- C. Formula (3)

Art Unit: 1639

- D. Formula (4)
- E. Formula (5)

Each of the species covered in each of the genus differs in structure and mode of action. A prior art reference anticipating one species would not render obvious the other species.

Applicant(s) is/are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 84 and 91-94 are generic.

Applicant(s) is/are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant(s) will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant(s)

Art Unit: 1639

must indicate which are readable upon the elected species. MPEF § 809.02(a).

Should applicant(s) traverse on the ground that the species are not patentably distinct, applicant(s) should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant(s) is/are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant(s) is/are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

F.P.: Ochiai/Brouwer Rejoinder form paragraph

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Application/Control Number: 10/724,233

Art Unit: 1639

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is(571)272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571)272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. D. Wessendorf Primary Examiner Art Unit 1639 Page 7

Application/Control Number: 10/724,233 Page 8

Art Unit: 1639

tdw

February 19, 2006